REMARKS

Claims 1 and 4-21 are pending. Reconsideration of all pending claims is respectfully requested in light of the foregoing amendments and following remarks.

Rejections under 35 U.S.C. § 103

Claims 1 and 4-21 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,787,175 ("Carter") in view of U.S. Patent Publication 2006/0173999 ("Rider") and further in view of U.S. Patent No. 7,017,183 to Frey et al. ("Frey"). In response, Applicants respectfully traverse the rejection of the claims on the grounds that the combination of references is defective in establishing a prima facie case of obviousness with respect to all of the claims.

In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Court stated that:

> *a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.*

Id. at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

> *The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.*

In the present application, a prima facie case of obviousness does not exist for the claims for the reasons set forth below.

MPEP 2143.03 states that "'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." However, in the present matter, the Examiner has not shown that all words in the claims have been considered. In particular, claim 1 requires, *inter alia*:

> *building a member definition comprising a member identifier, an access control list, a private key of a key pair for use in encrypting the document, and a digital signature, and associating the member definition with the user;*

(emphasis added).

Carter, which is cited by the Examiner as disclosing building a member definition, fails to teach the member definition including, *inter alia*, a private key of a key pair, as now recited in claim 1. The deficiencies of Carter are not remedied by Rider, which is cited as teaching linking the member definition to a first data portion of a document, receiving a request from the user to access the document, comparing the request with the access right, and allowing access to only the first data portion, or Frey, which is cited as teaching an access control list. In view of the foregoing, it is apparent that the cited combination fails to teach or suggest the invention as recited in claim 1; therefore, the rejection is not supported by the cited combination and should be withdrawn. Claims 11 and 21 include limitations similar to those of claim 1 and are therefore also deemed to be in condition for allowance for at least the same reasons presented above. Claims 4-10 and 12-20 depend from and further limit claims 1 and 11 and therefore are deemed to be in condition for allowance for at least that reason.

Conclusion

It is clear from all of the foregoing that all of the pending claims are now in condition for allowance and prompt notification to that effect is therefore respectfully requested. The Examiner is invited to contact the undersigned at the numbers provided below if further discussion is required.

Respectfully submitted,

Brandi W. Sarfatis
Registration No. 37,713

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HAYNES AND BOONE, LLP
2323 Victory Ave., Suite 700
Dallas, Texas 75219
Telephone: (214) 651-5896
Facsimile: (214) 200-0848
File: 26530.92

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I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on the following date.

Date: January 20, 2010

Ellen Lovelace